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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* JOSEPH WAYNE NORTON,
GARY HAYATO OGASAWARA, JONAN SCHWARTZ,
DAVID STONE, and MICHAEL MAN-HAK TSO

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Appeal 2009-012381
Application 10/686,741
Technology Center 2400

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Decided: June 29, 2010

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Before KENNETH W. HAIRSTON, THOMAS S. HAHN, and
BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF CASE

Appellants appeal under 35 U.S.C. §§ 6(b) and 134 from the Examiner's rejection of claims 1-36. Oral arguments were held June 22, 2010. We REVERSE.

## BACKGROUND

Appellants' invention relates to "techniques that provide improved scalability and fault-tolerance for storage and retrieval of messages destined for mobile devices" (App. Br. 2 (citing Spec. ¶ [0002])). More specifically, Appellants disclose

> [a] system and method of managing a network [that] provides for distributed storage and retrieval. In one embodiment, information such as a text message is stored by calculating an actual destination node based on a subscriber identifier and a current addressing function, [such as by hash functions,] which corresponds to a current topology of a network. The message is sent to the actual destination node for storage. Messages can be retrieved by calculating a plurality of destination nodes based on a subscriber identifier and a plurality of addressing functions, where each addressing corresponds to a topology of the network at a particular moment in time.

(Abstract).

Independent claim 1 is illustrative, reading as follows:

> 1. A method of managing a network, comprising:
>
> calculating a plurality of destination nodes based on a subscriber identifier and a plurality of addressing functions, each addressing function corresponding to a topology of the network at a particular moment in time;
>
> querying the calculated plurality of destination nodes for a message.

Claims 1-36 stand rejected under 35 U.S.C. § 102(b) as anticipated by Boyle (US 6,138,158, issued Oct. 24, 2000). Boyle relates to the navigation of Internet web pages using two-way interactive communication devices such as mobile and landline phones. These two-way communication devices can access hypermedia or hierarchic layers of information stored in network servers. When the information is updated, the communication devices do not receive the entire updated web page. Rather, Boyle's system "sends a notification to a proxy server that forwards the notification to the users using a messaging system via a low cost narrowband channel. Upon receiving the notification, the users can fetch the updates, when needed, through a wideband channel" (Boyle, Abstract).

The Examiner initially states that Boyle's mobile phones constitute the claimed "destination nodes" (*see, e.g.*, Ans. 10:5-6, 20). However, the Examiner subsequently states that Boyle's mobile phones alternatively constitute the claimed "plurality of addressing functions" (Ans. 11:5-8). Alternatively still, the Examiner also states that the claimed "plurality of addressing functions" read on the mobile phones' device IDs and subscriber IDs (*see, e.g.*, Ans. 9:19-21; 11:5-8).

The Examiner further interprets the claim 1 limitation, "querying the calculated plurality of destination nodes for a message," as reading on Boyle's confirmation of delivery notification (Ans. 10:7-8 (citing Boyle, col. 11, ll. 40-50)).

Appellants assert (1) "Boyle does not disclose that a plurality of mobile devices is calculated based on a subscriber identifier and a plurality of mobile devices"; (2) "Boyle does not disclose that each mobile device corresponds to a topology of the network"; and (3) "link server 114 sends

the update content notification message to mobile device 106, and accordingly link server 114 does not query mobile device 106 for the updated content notification message" and "there is no need to query for the confirmation receipt as the confirmation receipt is automatically sent by the mobile device" (Reply Br. 4).

The issues before us, then, are:

1. Has the Examiner erred in interpreting the claimed "destination nodes" as reading on Boyle's mobile devices?

2. Has the Examiner erred in interpreting the claimed "addressing functions" as reading on Boyle's mobile devices?

3. Has the Examiner erred in finding that Boyle discloses "querying the calculated plurality of destination nodes for a message"?

## FINDING OF FACT

The record supports the following Finding of Fact (Fact) by a preponderance of the evidence:

1. Appellants' Specification expressly distinguishes their invention (of storing messages in a networked message store that is composed of "nodes" of networked servers) from the prior art (wherein messages are stored on "destination user device[s]," such as mobile telephones, personal digital assistants, and pagers) (¶¶ [0004], [0016]-[0017]).

## ANALYSIS

The Examiner has not established that Boyle's mobile devices constitute either a "destination node" or an "addressing function" as used in the claims. We appreciate the Examiner's point that the claims' abstract

language renders the claims quite broad (*see* Ans. 8:1-10). However, the metes and bounds of the claim terms are not without limits. Rather, the claim terms must be afforded the broadest reasonable constructions that are *consistent with the Specification*. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

In the present situation, Appellants' Specification expressly distinguishes "nodes" (such as servers) from "user devices" (such as mobile phones) (Fact 1). Based upon the usage of "node" within the context of Appellants' Specification, then, it is not reasonable to interpret Boyle's mobile devices as constituting the claimed destination nodes. Office personnel must rely on Appellants' disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc). "[I]nterpreting what is *meant* by a word *in* a claim is not to be confused with adding an extraneous limitation appearing in the specification, which is improper." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1348 (Fed. Cir. 2002) (citation omitted) (internal quotation marks omitted).

Furthermore, the Examiner has failed to establish that the claimed "addressing functions" can be interpreted to be anticipated either by Boyle's mobile devices, or alternatively, by the device IDs and subscriber IDs of the mobile devices. A mobile device would be commonly understood to be hardware. The various IDs would be commonly understood to constitute data. We fail to see how either hardware or data can be interpreted as constituting any kind of function, let alone an addressing function.

Finally, the Examiner has not established that Boyle discloses "querying the calculated plurality of destination nodes for a message." The

passage of Boyle cited by the Examiner (Ans. 10:7-8 (citing Boyle, col. 11, ll. 40-50)) discusses a messenger 208 that assigns identifications to received message notifications "to ensure that all notifications will be eventually delivered . . . . For every confirmed delivered notification, messenger 208 updates queue list 326 by, for example, stamping a confirmation thereto or simply removing the confirmed delivered notification from queue list 326" (Boyle, col. 11, ll. 41-48). The cited section contains no discussion, though, of any component sending any queries.

For the foregoing reasons, Appellants have persuaded us of error in the Examiner's anticipation rejection of independent claim 1. Like claim 1, all of the other independent claims, claims 14, 21, and 34, also recite nodes, addressing functions, and a step for either querying or sending a message retrieval request to the nodes. Accordingly, we will not sustain the Examiner's rejection of independent claims 1, 14, 21, and 34, as well as claims 2-13, 15-20, 22-33, 35, and 36, which depend therefrom.

## DECISION

The Examiner's decision rejecting claims 1-36 is reversed.

## REVERSED

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